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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.      | CONFIRMATION NO.       |
|--|-------------|----------------------|--------------------------|------------------------|
| 10/804,909   | 03/19/2004  | Stephan Sattler      | RDID03079US              | 8358                   |
| 23690 7590 06/07/2007<br>ROCHE DIAGNOSTICS OPERATIONS INC.<br>9115 Hague Road<br>Indianapolis, IN 46250-0457 |             |                      | EXAMINER<br>AKRAM, IMRAN |                        |
|  |             |                      | ART UNIT<br>1709         | PAPER NUMBER           |
|  |             |                      | MAIL DATE<br>06/07/2007  | DELIVERY MODE<br>PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                               |                                  |  |
|------------------------------|-------------------------------|----------------------------------|--|
| <b>Office Action Summary</b> | Application No.<br>10/804,909 | Applicant(s)<br>SATTLER, STEPHAN |  |
|                              | Examiner<br>Imran Akram       | Art Unit<br>1709                 |  |

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 March 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☒ Claim(s) 4 and 7 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>3/19/04</u> . | 6) <input checked="" type="checkbox"/> Other: <u>IDS 9/15/04</u> .                      |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, 4, and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Rudi (5,372,264).
3. Regarding claim 1, Rudi discloses a vessel holding device comprising a holding zone having a surface and provided with a holder opening to hold a vessel (column 3, lines 8-13) characterized in that the surface of the holding zone comprises an electrically conductive material (column 3, lines 19-23) connected to an electrical reference potential (column 3, lines 26-29).
4. Regarding claim 4, Rudi discloses a holding zone comprising a base body coated with a surface layer comprising an electrically conductive material (column 3, lines 26-29).
5. Regarding claim 5, Rudi discloses a base body comprising of plastic (column 5, lines 6-7).

Art Unit: 1709

6. Claims 1, 4, and 5 are rejected under 35 U.S.C. 102(e) as being anticipated by Moritz (US 2003/0152494).
7. Regarding claim 1, Moritz discloses a vessel holding device comprising a holding zone having a surface and provided with a holder opening to hold a vessel (paragraph 10), characterized in that the surface of the holding zone comprises an electrically conductive material (paragraph 19) connected to an electrical reference potential (paragraph 12).
8. Regarding claim 4, Moritz discloses a holding zone comprising a base body coated with a surface layer comprising an electrically conductive material (paragraph 19).
9. Regarding claim 5, Moritz discloses a base body comprising of plastic (paragraph 11).

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

Art Unit: 1709

2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

12. Claims 2-6 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Moritz (US 2003/0152494).

13. Regarding claim 2, Moritz discloses the electrically conductive material to be metal (paragraph 17). Moritz does not, however, disclose the metal being nickel, nickel alloy, gold, silver, titanium, and/or chromium. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use one of these metals for the electrically conductive material as these metals are commonly known in the art to be conductive.

14. Regarding claim 3, Moritz discloses the electrically conductive material to be metal (paragraph 17). Moritz does not, however, disclose the metal being nickel or a nickel alloy. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use one of these metals for the electrically conductive material as these metals are commonly known in the art to be conductive.

15. Regarding claim 4, Moritz discloses a holding zone comprising a base body coated with a surface layer comprising an electrically conductive material (paragraph 19).

16. Regarding claim 5, Moritz discloses a base body comprising of plastic (paragraph 11). Moritz does not, however, the base body comprising of aluminum, an aluminum alloy, or magnesium. It would have been obvious to one

Art Unit: 1709

having ordinary skill in the art at the time the invention was made to use one of these metals for the base body as they are commonly found to in the art as base materials often being coated.

17. Regarding claim 6, Moritz does not disclose the method of manufacturing the electrically conductive surface. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use either galvanic nickel plating, chemical nickel plating, and/or plasma coating to do so as these are common methods to coat metals upon various surfaces, especially plastic.

18. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Moritz as applied to claim 1 above, and further in view of Vexler (US 4,773,976).

19. Vexler discloses manufacturing an electrically conductive surface by plasma coating (see abstract). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use plasma coating to do so as this common method to coat conductive metals upon various surfaces.

20. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Moritz as applied to claim 1 above, and further in view of Williamson (US 4,840,771).

21. Williamson discloses a sample holding device surrounded by an incubator (see Figure 1). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the vessel holding device of Moritz in an incubator as it is common laboratory equipment and Moritz is meant to be used in laboratory experiments (paragraph 2 of Moritz).

***Claim Objections***

22. Claim 4 is objected to because of the following informalities: aluminum is spelt aluminium. Appropriate correction is required.

23. Claim 7 is objected to because of the following informalities: the vessel holding device is referred to as the sample holding device. Consistency is recommended. Appropriate correction is required.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Imran Akram whose telephone number is 571-270-3241. The examiner can normally be reached on 8-6 Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Walter Griffin can be reached on 571-272-1447. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1709

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

IA

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